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In re Application of:
Robert B. Wood
Application No. 09/938,144
Filed: 23 August 2001
For: INTELLIGENT DATA STORAGE
DEVICE

DECISION ON PETITION TO
WITHDRAW THE FINALITY OF
AN OFFICE ACTION

This paper provides the decision on the petition filed December 11, 2006 under 37 C.F.R. § 1.181 and M.P.E.P. § 706.07 to withdraw the finality of the Office action, mailed September 11, 2006.

The Petition is **DISMISSED**.

RECENT PROSECUTION HISTORY

In the Non-Final Office Action, mailed March 1, 2006, the Examiner rejected claims 1 and 18 as being unpatentable over Hacker [MP3: The Definitive Guide, published March 2000] in view of Bruner et al. [US 6,212,588 BI]

Applicants responded on June 29, 2006 by amending claims 1 and 18.

The amendment to claim 1 changed the claim preamble from being a claim for a "data storage device in a form factor assembly not greater than three and one half inches" to "a device".

Applicants also amended the claim to remove the following elements from the claim:

an actuator arm adjacent to the data disc carrying a transducer for reading data from and writing data to the data disc;
memory storing an application program operably connected to the CPU, whereby the application program is run by the CPU.

Further Applicants amendment also changed :

a printed circuit board (PCB) fastened to the base-plate having a servo controller in operable communication with the actuator arm for moving the actuator arm over the data disc;

to

a printed circuit board (PCB) fastened to the base-plate having a servo controller;

and changed

a central processing unit (CPU) mounted to the PCB generating control signals to the servo controller and running an operating system;

to

a central processing unit (CPU) mounted to the PCB running an operating system;

The amendment to claim 18 changed the limitation

a data disc mounted within the case, wherein the data disc rotates about a central axis;

to

a data disc mounted within the case,

and removed the limitation

an actuator arm carrying a head to read and write data to the data disc;

On September 11, 2006, the Examiner issued a final action. Examiner applied a new grounds of rejection under 35 U.S.C. 102(e) over Stefanksy [US 6,226,143 B1], and indicated that applicants' amendment necessitated the new grounds of rejection.

Applicants petitioned on November 13, 2006 that the second Office action was made final prematurely. This petition was treated as a Request for Reconsideration, and the examiner issued an advisory action stating that "the claims, as amended, no longer requires the device to be a data storage device with form factor assembly of less than three and one half inch and the actuator arm adjacent to the data disc carrying a transducers and a memory. The amended claims at current directs toward a PCB fastened to a baseplate having servo controller in combination with a CPU mounted to the PCB. As can clearly be seen, the claims filed on 6/29/06 is of different scope than the claims filed on 8/25/06, applicant's argument regarding the combination of Hacker and Bruner is therefore moot and necessitated the search and the new ground of rejection as set forth in the final office action".

REQUIREMENTS

A petition under 37 CFR § 1.181 must include: (1) a statement of facts involved and (2) the point or points to be reviewed and the action requested. Note, the mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. In addition § 1.181 (f) sets forth: any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely. Further, when a petition is taken from an action or

requirement of an examiner in the ex parte prosecution of an application, ... it may be required that there have been a proper request for reconsideration (37 CFR § 1.111) and a repeated action by the Examiner.

The petition filed on November 13, 2006 includes elements (1) and (2) above, as well as a request for reconsideration. The advisory action mailed on November 20, 2006, constitutes a repeated action by the Examiner.

RELIEF REQUESTED

The instant petition filed under 37 CFR 1.181 requests the withdrawal of the finality of the September 11, 2006 office action.

OPINION

Petitioner presents the following arguments in support of the position that the Final rejection was premature:

- a) The (final) Office action rejection of claims 1 and 18 under 35 U.S.C. 102 (e), as being anticipated by Stefansky [US 6,226,143 B1], is improper as the Examiner applied new grounds of rejection to claims broadened by applicants' amendment. If the rejection under 35 U.S.C. § 103(a) as being obvious over Hacker in view of Brunet et al. of claims 1 and 18 prior to the broadening amendment had properly supported the rejection, the same grounds of rejection would have also supported a rejection of claims 1 and 18 as broadened after the amendment. For this reason, Applicant's amendment submitted June 29, 2006 could not have necessitated the new grounds of rejection as set forth in the Final Office Action with respect to at least claims 1 and 18.
- b) Applicants' petition recites (p.2, last paragraph) "because the amendment submitted June 29, 2006 did not further limit the scope of claims 1 and 18 in any way, that the amendment could not have necessitated the new grounds of rejection of claims 1 and 18 as required for a proper Final Office Action".

ANALYSIS

M.P.E.P. § 706.07(a) provides that "second or any subsequent actions on the merits *shall* be final, except where the Examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor [other grounds not pertinent here]" (emphasis added).

In the instant case, applicant's amendment changed the claim scope (as shown in the Recent Prosecution History section above) that it was no longer needed that the reference teach "a data storage device in a form factor assembly not greater than three and one half inches" as recited in claim 1. Claim 18 was also amended to remove "an actuator arm carrying a head to read and write data to the data disc". Hacker was specifically cited "for the actuator arm" and "data storage device". By removing these limitations from the claim, applicant made the claim broad. Thus other references that were not available as prior art for the original claims, became available as prior art for the amended claims. Hence, the new grounds of rejection were necessitated by applicant's amendment. M.P.E.P. § 706.07(a) only requires that the new grounds of rejection be necessitated by Applicants amendment. It does not require that the amendment be "further limiting" as argued by applicant.

With respect to Petitioners' argument that "Applicant finds no support in the MPEP or elsewhere for the proposition that an amendment that only broadens the scope of a claim can necessitate a new ground of rejection", while the undersigned agrees with that statement, the undersigned also would like to point out that there also is no support in the MPEP that the amendments have to be further limiting the scope of a claim to be made final with a new grounds of rejection as argued by the petitioners.


With respect to Petitioners' argument that

Because Applicant did not add any features in claim 1 or claim 18, it is clear that Applicant's amendments only broadened the subject matter of claims 1 and 18. If the rejection under 35 U.S.C. § 103(a) as being obvious over Hacker in view of Brunet et al. of claims 1 and 18 prior to the broadening amendment had properly supported the rejection, the same grounds of rejection would have also supported a rejection of claims 1 and 18 as broadened after the amendment. For this reason, Applicant's amendment submitted June 29, 2006 could not have necessitated the new grounds of rejection in set for the in the Final Office Action with respect to at least claims 1 and 18.

However, it is noted that the claims 1 and 18, in their amended format, did not require some of the essential elements that the Hacker (primary) reference was relied upon to teach. MPEP 706: (2) provides that in rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. MPEP 706.02 I. CHOICE OF PRIOR ART; BEST AVAILABLE provides that prior art rejections should ordinarily be confined strictly to the best available art. Hence, examiner applied the new grounds of rejection commensurate with the amended scope of the claims 1 and 18, and commensurate with office practice and procedures.

The petition is **DISMISSED**.

The application remains under final rejection with the time period for response continuing to run from the mailing of the Final Office action, September 11, 2006.



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